

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

FLAGSTAR BANK, FSB,)	FILED: MARCH 30, 2009
)	09CV1941
Plaintiff,)	JUDGE KENDALL
)	MAGISTRATE JUDGE KEYS
vs.)	CH
)	
FREESTAR BANK, N.A.,)	
)	
Defendant.)	

**DEFENDANT'S MOTION TO QUASH SUBPOENA
DUCES TECUM IN A CIVIL CASE**

Defendant, FREESTAR Bank ("Defendant"), pursuant to Federal Rule of Civil Procedure 45, respectfully submits this Motion to Quash a subpoena *duces tecum* issued to the law firm Barack Ferrazzano Kirschbaum & Nagelberg (of Chicago, Illinois), and in support of the Motion states:

1. The subpoena is a third-party *duces tecum* subpoena issued by the attorneys for Plaintiff Flagstar Bank, FSB, which, in the underlying matter pending in the Central District of Illinois, has sued Defendant FREESTAR Bank, N.A., alleging (among other things) trademark infringement.
2. The underlying case pending in the United States District Court is Flagstar Bank, FSB, v. FREESTAR Bank, N.A., Case No. 1:08-cv-01278-MMM-JAG. The subpoena is attached as Exhibit 1.
3. Plaintiff issued the subpoena in the name of this Court on the law firm Barack Ferrazzano Kirschbaum & Nagelberg, LLP ("Barack Ferrazzano").

4. Barack Ferrazzano was retained by Defendant for legal counsel and work in connection with Defendant's name change. *See* March 27, 2009 Letter of Objections to Subpoena by Ed Malone, Attorney at Barack Ferrazzano, Exhibit 2.

The First Subpoena:

5. This is actually the *second* subpoena served on the law firm Barack Ferrazzano Kirschbaum & Nagelberg, LLP ("Barack Ferrazzano"). Plaintiff issued its first subpoena in the name of the United States District Court for the Central District of Illinois. It sought "[a]ll documents and things including, but not limited to, correspondence, memoranda, surveys, tests, studies and reports, which evidence, refer or relate to the creation and/or selection of the name Freestar Bank and the mark Freestar Bank 'Life Keeps Getting Better,' as well as any names or marks which were considered and rejected by the Tracey Edwards Company, Inc. and/or Freestar Bank." *See* Exhibit 3.
6. On behalf of Defendant, Barack Ferrazzano's attorney Ed Malone objected to the first subpoena on the grounds that it sought privileged matter. *See* March 3, 2009 Letter of Objections, Exhibit 4.
7. On March 10, 2009, Plaintiff's attorney Chanille Carswell responded to these objections by stating: "We appreciate that any communication between Barack Ferrazzano and Freestar Bank, N.A. ("Freestar") regarding the results of such a [trademark] search and/or which include Barack Ferrazzano's legal impressions, conclusions, or advice may be privileged." Exhibit 5 at 1.
8. On Defendant's Motion, the District Court issued an order quashing the subpoena on March 11, 2009 because the subpoena was invalid on its face. The Court did

not reach Defendant's additional ground for quashing the subpoena: namely, that the subpoena seeks information protected by the attorney-client privilege. *See* Federal Rule of Civil Procedure 45(c)(3)(A)(iii) (requiring the issuing court to quash or modify a subpoena that "*requires disclosure of privileged or other protected matter*, if no exception or waiver applies") (emphasis added). The Court's Order states: "If the subpoena is properly re-issued, Defendant may re-raise those arguments not addressed by this Order." *See* Exhibit 6.

This Second Subpoena:

9. Despite Plaintiff's counsel's March 10, 2009 clarification that Plaintiff was not seeking privileged communications between Barack Ferrazzano and Defendant, Plaintiff's second subpoena served on Barack Ferrazzano *is identical to the first* (in describing the documents sought by Plaintiff). Plaintiff issued the subpoena in the name of this Court on March 13, 2009 and served the subpoena on Barack Ferrazzano on March 16, 2009. The subpoena's compliance date is March 30, 2009 (*see* Exhibit 1).
10. On Friday, March 27, 2009, Barack Ferrazzano attorney Ed Malone again objected to the subpoena. *See* Exhibit 2. Mr. Malone also submitted a 11-page privilege log listing and describing matter otherwise falling within the scope of the subpoena but plainly privileged under the attorney-client privilege or the attorney work-product privilege. *See* Barack Ferrazzano privilege log, attached as Exhibit 7.

11. As conceded by Plaintiff's counsel in her March 10 letter, the unmodified second subpoena must be quashed because compliance would require the disclosure of privileged matter.
12. For completeness, Defendant has consistently asserted privilege with respect to communications from the Barack Ferrazzano firm that concern Defendant's adoption of the FREESTAR Bank mark. *See* Letters of Objections (Exhibits 2 and 4) and Defendant's Privilege Log (Exhibit 8).

Plaintiff's Second Subpoena Partly Overlaps With Yet Another Third-Party Subpoena Served by Plaintiff

13. Defendant has also filed (and both Defendant and Plaintiff have briefed) a Motion to Quash a Third Party *Duces Tecum* subpoena in the United States District Court for the District of New Hampshire. Plaintiff subpoenaed another third party, The Tracey Edwards Co., Inc. (Tracey Edwards), a marketing consulting company in New Hampshire that worked with Defendant for over one year on Defendant's name change, branding, and advertising. The subpoenas served on Tracey Edwards and Barack Ferrazzano are identical in terms of the documents they seek relating to Defendant's name change. *See* Exhibit 9 (Tracey Edwards subpoena).
14. The overlap between Defendant's Motion to Quash in this Court and Defendant's Motion to Quash in the District Court for New Hampshire is this: an April 13, 2006 letter, identified as Document No. 8 in Barack Ferrazzano's privilege log (Exhibit 7). The April 13 letter overlaps because (1) it was addressed from Barack Ferrazzano attorney Malcolm McCaleb to Ed Vogelsinger at FREESTAR Bank; if not considered privileged, it would fall within the scope of the subpoena served on Barack Ferrazzano; and (2) Mr. Vogelsinger sent a handwritten note to

Defendant's account executive at Tracey Edwards and attached the April 13 letter from his attorneys to the note; if not considered privileged, the note and attached letter would fall within the scope of the subpoena served on Tracey Edwards in New Hampshire.

15. The letter from Malcolm McCaleb to Ed Vogelsinger, and the handwritten note (with attached letter) from Vogelsinger to its account executive, are both listed in Defendant's privilege log. See Exhibit 8.

Conclusion and Requested Relief

16. As it stands, Plaintiff has not formally modified its subpoena, though it concedes that complying with the subpoena would mean disclosing privileged matter. That alone constitutes grounds for this Court to quash the subpoena under Rule 45(c)(3)(A)(iii). In the alternative, the Court should modify the subpoena to eliminate disclosure of the privileged matter contained in the Barack Ferrazzano privilege log (Exhibit 7).

Respectfully submitted,

FREESTAR BANK, N.A.
Defendant

by,

s/ Robert A. Kearney
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Dated: March 30, 2009

**DEFENDANT FREESTAR BANK'S NOTICE OF FILING,
CERTIFICATE OF SERVICE, AND DESIGNATION OF LOCAL COUNSEL UNDER
LOCAL RULE 83.15**

Now comes Defendant, FREESTAR Bank, N.A., by and through its attorneys, and gives Plaintiff notice that on March 30, 2009, Robert A. Kearney caused the foregoing **Defendant's Motion to Quash Subpoena Duces Tecum in a Civil Case** to be filed electronically with the Clerk of the Court in this case using the ECF System, which will send notification to the following registered participants of the System: None.

I also certify that I have electronically mailed the filing on this date to the following non-participants in the ECF System: Jordan Fifield, Fadi Rustom, Molly Mack Crandall, Kevin Heinl, Robert Tuttle, Chanille Carswell, and Ed Malone (Barack Ferrazzano). I have also sent the filing by overnight mail to Attorneys Tuttle, Heinl, Crandall, and Carswell at: Brooks Kushman, 1000 Town Center, 22nd Floor, Southfield, MI 48075.

The following attorney is designated as local counsel under Local Rule 83.15:

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Respectfully submitted,

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Dated: March 30, 2009